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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,552	01/12/2001	David Edward Wilson	8394	1164
7590 07/10/2008				
James J. Napoll, Ph.D. Marshall, Gerstein & Borun LLP 233 South Wacker Drive 6300 Sears Tower Chicago, IL 60606-6357			EXAMINER NGUYEN, DINH Q	
			ART UNIT 3752	PAPER NUMBER
			MAIL DATE 07/10/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/759,552

Applicant(s)

WILSON ET AL.

Examiner

Dinh Q. Nguyen

Art Unit

3752

**Period for Reply**  
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The limitations “deactivating” and “activating” of claims 1, 8, 9, and 13 have not been cited in the specification as such.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 and 13 are directed to neither a “process” nor a “machine”, but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the classes of invention in the alternative only (see MPEP 2173.05(p)). Claims 1 and 13 are apparatus claims, however, the amended limitation introducing the method steps of “deactivating” and “activating” to the claims.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amended limitation “said high voltage power supply at least one of deactivating the delivery of the product from the reservoir prior to

deactivating and activating prior to activating the delivery of the product from the reservoir" is not clearly disclosed the invention in such a way that could be understood by the examiner, the limitation should be clearly reciting the claimed invention as described in the specification such as "the high voltage power supply charges the high voltage electrode to a predetermined voltage level before the product is delivered to the charging location. During shut-down, the product delivery is stopped before the high voltage power supply shuts off power to the high voltage electrode". Furthermore, Claims 1 and 13 combines description of the apparatus with description of method for using the apparatus and violates second paragraph of 35 USC 112 (see MPEP 2173.05(p)). The purpose of that paragraph is to require patentee to provide others with notice of boundaries of protection provided by patent, since manufacturer or seller, at time of making or selling the apparatus set forth in claim, would have no indication whether it might later be sued for contributory infringement if apparatus is used in accordance with claimed method, and since claim is thus not sufficiently precise that possibility of infringement may be determined with reasonable degree of certainty, wherein the amended limitation introducing the method steps of "deactivating" and "activating" to the claims. Applicant is required to cancel claims 8 and 9, since the limitations of claims 8 and 9 have been incorporated into claims 1 and 13, and claims 8 and 9 do not further limit the claimed invention.

5. For the purpose of this Office action, the claims will be examined as best understood by the examiner.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkins et al. as best understood by the examiner.

Perkins et al. teaches all the limitations of the claims except for the high voltage power supply is activated to charge the high voltage electrode to a predetermined voltage level before the product is delivered to the charging location, or the product delivery is deactivated before the high voltage power supply shuts off power to the high voltage electrode. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the device of Perkins et al. with the high voltage power supply is activated to charge the high voltage electrode to a predetermined voltage level before the product is delivered to the charging location, or the product delivery is deactivated before the high voltage power supply shuts off power to the high voltage electrode. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either claimed invention or the Perkins et al. invention. Therefore, it would have been an obvious matter of design choice to modify the device of Perkins et al. to obtain the invention as specified in claims 1 and 13 in order to provide an effective and safe spraying device.

***Response to Arguments***

8. Applicant's arguments filed February 27, 2008 have been fully considered but they are not persuasive. It would be obvious matter of design choice to one skilled in the art to reconfigure the Perkin et al. device to fully charge the electrode before spraying of the product to ensure proper charging of the spraying fluid, the fully charged spray fluid would be fully adhered to the coated the object, similarly, at the end of the spraying cycle, the spraying fluid is stopped before deactivating the voltage power supply for ensuring the spaying fluid is fully charged until the end of the spraying cycle.

9. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection as indicated above.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh Q. Nguyen whose telephone number is 571-272-4907. The examiner can normally be reached on Monday-Thursday 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on 571-272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3752

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dinh Q Nguyen/  
Primary Examiner, Art Unit 3752

dqn